

Serial No.: 10/507,467

Office Action Date: October 28, 2008

Amendment Dated: January 27, 2009

REMARKS

Reconsideration of this application is respectfully requested. Applicants believe that consideration of this amendment is proper because they have attempted to comply with every requirement expressly set forth in the previous Office Action dated October 28, 2008 (Paper No. 20081023) and believe the application is now in condition for allowance.

Claims 1, 20 and 22 have been amended to specify that the first surface of the attachment member, to which the porous body is attached, is substantially planar. Support for this amendment is found in the specification on page 8, lines 33-36. Further, these claims now feature a porous body made of a foam rubber-like material through which the incoming air passes. No new matter is believed to be introduced by these amendments.

Claims 1-2, 4-7, 13, 15, 17-21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Flower in U.S. Patent No. 3,520,300. Applicants respectfully traverse the rejection. It would not be obvious to modify Flower as suggested by the Examiner because there would be no filtration if operated as suggested by the Examiner and because it would render the referenced invention unsuitable for its intended use. Thus no *prima facie* case of obviousness has been established.

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Flower fails to disclose the gas source that has been included by amendment in claims 1, 20 and 22. The Examiner contends that the gas source is supplied by a suction device that could be run in a reverse mode to supply gas. The Examiner contends that “suction pumps are capable of [operating in] (sic) a reverse mode of delivering air rather than suctioning it” even though Flower does not disclose using it in this manner.

If the suction device or Flower were operated in reverse, element 50 would not act as a separator of any kind and there would be no filter. Applicants reassert arguments in previous responses that the separation device of Flower is not a “filter” as that word is commonly used. Support was furnished with Amendment C showing that a “filter” requires passing a gas or a liquid through a porous medium in order to separate components. The liquid trap of Flower does not meet this criterion. Flower further fails to utilize the right to be his own lexicographer and define the term “liquid trap” to recite common filters.

Flower teaches that drawing blood and other liquid materials into the liquid trap 50 where they are collected for disposal. Traps of this type rely on gravity to retain the liquid in the trap while the gases flow through to the suction pump 54. Operation of the suction pump in reverse would blow air into the trap and through the device. No liquid would be present and nothing would be separated. Therefore, even if Flower’s trap were construed to be a filter when the device were operated as suggested by Flower, no

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filter would be present when the Flower device was operated as suggested by the Examiner.

This rejection is also improper because the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose. Flowers' invention is described as "a surgical device for removing blood from a wound". See, column 1, lines 20-21. Reversal of the pump to supply air results in no removal of blood from the surgical field. In fact, pump reversal would spread blood within the field or cause it to splatter out, causing contamination of additional tissues. Since Flower would be rendered unsuitable for its intended purpose, there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

In Amendment E, Applicants argued that one skilled in the art would not reverse the suction pump to deliver air because of the risk of contamination. The Examiner as replied that this "is not the issue at hand." Applicants contend that this is a relevant issue because a surgical device that contaminated the surgical field would no longer be useful. As discussed above, there is no motivation to modify an apparatus when doing so would make it unsuitable for its intended purpose. *Id.*

Thus, none of Applicants' claims are anticipated by Flower in U.S. Patent No. 3,520,300. No *prima facie* case of obviousness has been established because there is no motivation to make the proposed modifications. Even if Flower were modified as

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suggested, all features of Applicants' claims are not present and Flower cannot be shown to anticipate the claims. Applicants have traversed the rejection and respectfully request that this rejection be withdrawn.

Claims 1-2, 4-6, 13, 15 and 17-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Heaton et al. in WO 99/13793 in view of Flower. Heaton does not teach or suggest inclusion of a filter in the supply conduit. There is no motivation for an artisan to modify the apparatus of Heaton as suggested by the Examiner. Applicants respectfully traverse this rejection as no *prima facie* case of obviousness has been established.

The Examiner suggests that the device of Heaton is capable of supplying a gas to an area. Heaton describes a "drape and suction head combination for attaching the suction head to a wound area." See, Abstract. Reversal of the catheter to provide a gas instead of provide suction would render Heaton's device unsuitable for its intended purpose. Therefore, applying the principles of *In re Gordon* as above, there would be no motivation for an artisan to modify Heaton in this manner.

Even if the references are combined as suggested in the outstanding Office Action, each and every feature of Applicants' claims has not been shown. Neither Flower nor Heaton suggest either a filter or a gas source. When combined are as suggested, the combination of Flower and Heaton fails to reveal a filter, since even the trap of Flower would fail to operate as a separation device since liquid from the wound is

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no longer drawn into the trap. No other filter is taught or suggested in either reference.

Since these same claim elements are absent from Flower, even in combination, all elements of Applicants' claims are not described.

Therefore, since all features of Applicants' claims are not shown and there is no motivation to modify the references as suggested, it has been demonstrated that no *prima facie* case of obviousness has been shown. Applicants respectfully request that the rejection be withdrawn and the subject claims allowed to issue.

Claims 8-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Flower in view of Heimlich in U.S. Patent No. 3,762,372. No gas source or filter is taught in either of the references, and therefore cannot be present in the combination. Applicants traverse this rejection as no *prima facie* case of obviousness has been established.

Even if Heimlich teaches all that the Examiner represents, it fails to cure the deficiencies of Flower with respect to claim 1. Arguments asserted above with respect to the § 102 rejection of Flower are reasserted here. With at least two claim elements absent, each and every claim element is not taught by the combination of Heaton, Flower and Heimlich.

In view of these deficiencies, no *prima facie* case of obviousness has been established. Applicants respectfully request that this rejection be withdrawn and that the subject claims be allowed to issue.

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Claims 8-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Heaton in view of Flower and further in view of Heimlich. No gas source or filter is taught in any of the references, and therefore cannot be present in the combination. Applicants traverse this rejection as no *prima facie* case of obviousness has been established.

Even if Heimlich teaches all that the Examiner represents, it fails to cure the deficiencies of Flower with respect to claim 1. Arguments asserted above with respect to the § 102 rejection of Flower are reasserted here. With at least two claim elements absent, each and every claim element is not taught by the combination of Heaton, Flower and Heimlich.

In view of these deficiencies, no *prima facie* case of obviousness has been established. Applicants respectfully request that this rejection be withdrawn and that the subject claims be allowed to issue.

Claim 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Flower in view of Wood. Arguments asserted above with respect to the presence of a gas source are reasserted here. No gas source is revealed in either of the references, therefore, it cannot be present in the combination. Arguments asserted above with respect to motivation to combine are reasserted here. Since no *prima facie* case of obviousness has been established, Applicants respectfully request that the rejection be withdrawn.

None of the cited references provides a gas delivery system. Further, the outstanding Office Action evidences picking and choosing of elements in the reference, applying them where there is no suggestion or motivation to do so. References should be considered for all that they disclose. Here, the Examiner has suggested modification of the references without regard to rendering the prior art apparatus unsuitable for its intended purpose.

Claims 1-2, 4-7, 13, 15 and 17-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Clark et al in U.S. Patent No. 4,624,656 in view of Wagner in U.S. Patent No. 5,738,656. Applicants submit that the combined disclosures of Clark and Wagner fail to disclose all features of Applicants' claims. Applicants respectfully traverse this rejection.

Clark discloses a device that delivers a gas to an area, however, it fails to disclose distribution of the gas through the foam rubber-like material. The system of Clark delivers the gas in one of two ways. A first embodiment, as shown in Fig. 1, brings the gas into a casing 7 where it flows around the resilient pad 3 as indicated by arrows 23. The gas flows into the central circular aperture 5 where it contacts the wound. In a second embodiment of Fig. 2, a fitting 42 through the resilient pad 32 delivers the gas directly from the supply tubing to the central circular aperture to the wound. Neither of these embodiments shows delivery of the gas to the resilient pad and transmission of the gas through the foam rubber-like pad as featured in Applicants' amended claims. Better

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distribution and control of the gas are achieved by forcing the gas to flow through the foam rubber-like material. Thus, this feature of the claims is not taught by the combination of references.

The amended claims also feature an attachment member having planar surfaces. Shaping of the attachment member in this way has the additional advantage of at least partially preventing backflow of the gas supplied through the porous body. This feature is not taught or suggested by the combination of Clark and Wagner.

Further, the combination of Clark and Wagner would operate differently from Applicants' proposed device. The apparatus suggested by the Examiner has the gas flow around the resilient pad. Applicants' device obtains better control and distribution of the gas by forcing the gas through the foam rubber-like material. Utilization of the proposed device in this manner would change the principle of operation under which the prior art device was designed to operate. When this occurs, the combination of references is not sufficient to render the subject claims obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Since all elements of Applicants' amended claims are not taught or suggested by the combination of Clark and Wagner suggested by the Examiner, no *prima facie* case of obviousness has been established. Applicants have traversed this rejection and respectfully request that the rejection be withdrawn.

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By the above arguments and amendments, Applicants believe that they have complied with all requirements expressly set forth in the pending Office Action. Issuance of a Notice of Allowance on the remaining allowed claims is respectfully requested. Should the Examiner discover there are remaining issues which may be resolved by a telephone interview, he is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

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January 27, 2009

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